

**U.S. Serial No. 09/766,525
Response to the Office Action Dated January 13, 2005**

In the Drawings:

Please accept the enclosed amended drawings. The amendments are as follows: On Figures 1 and 2, reference number 300 becomes 290.

No new matter has been introduced.

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REMARKS

The applicant has carefully considered the Office action dated January 13, 2005, and the cited portions of the applied references. By way of this Response, claims 1, 7, 8, 31, 32, 62, 63, 92, 93, 95, and 120 have been amended and claims 22, 53, 83, and 111 have been cancelled without prejudice to their future prosecution. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

The Rejections under 35 U.S.C. § 112

Claims 7, 8, 31, 62, 92, 95, and 120 were rejected under 35 U.S.C. § 112 ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, these claims were rejected for lacking antecedent bases. It is respectfully submitted that the foregoing amendments eliminate any indefiniteness that may have existed.

The Rejections under 35 U.S.C. §§ 102 and 103

Claims 1-9, 17, 23-26, 29-35, 40, 48, 54-57, 60-65, 70, 78, 93, 78, 106, 112-115, and 118-120 were rejected under 35 U.S.C. § 102 as being anticipated by Wood et al. (U.S. Pre Grant Pub. 2002/0054752). Claims 13, 44, 74, and 102 were rejected under 35 U.S.C. §103 as unpatentable over Wood. Claims 10-1, 14-15, 18-22, 36-39, 41-42, 45-46, 49-53, 66-69, 71-72, 75-76, 79-87, 90-92, 94-97, 99-100, 103-104, and 107-111 were rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Gudesen (U.S. Pat. 5,761,607). Claims 12, 73 and 101 were rejected under 35 U.S.C. §103 as

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unpatentable over Wood in view of Halford (U.S. Pat. 5,283,791). Claim 43 was rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Gudesen and Halford. Claims 16, 47 and 105 were rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Hassell (U.S. Pre Grant Pub. 2004/0128658). Claim 77 was rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Gundesen and Hassell. Claims 27, 58 and 116 were rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Sezan (U.S. Pat. 6,236,395). Claim 88 was rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Gudesen and Sezan. Claims 28, 59 and 117 were rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Tsukidate (U.S. Pat. 6,714,722). Claim 89 was rejected under 35 U.S.C. §103 as unpatentable over Wood in view of Gudesen and Tsukidate. The rejections are traversed and reconsideration is respectfully requested. Based on the foregoing amendments and the following remarks, it is respectfully submitted that claims 1-21, 23-52, 54-82, 84-110, and 112-120 are in condition for allowance.

Applicant's disclosure is directed to a video-on-demand system in which programs can be replayed while a video-on-demand library, which contains content that is potentially desirable to the user, is built. Currently, independent claims 1, 32, 63 and 93 have been amended to include the recitation that the potentially desired content may be recorded or stored at a rate faster or slower than normal speed.

Wood is directed towards a video data recording system that has personal channels. Wood discloses a system wherein live television broadcasts are captured in real time and may be replayed at the user's

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direction (see Wood ¶ [0037] where the system scans for "current" and "available" programming). In the Wood system, a user inputs criteria for requesting the type of video programming the user would like to have recorded. The system then scans available programming to determine if there are any programs that meet the user's criteria. If multiple programs simultaneously meet the user's criteria, the system determines which should be recorded, and, with sufficient resources, will use multiple input streams to record multiple video programs (Wood ¶ [0038]).

While Wood discloses a real-time audio-visual capture system, it is respectfully submitted that the cited portions of Wood do not disclose or suggest that potentially desired content can be recorded or stored at a rate faster or slower than normal speed.

The recitation that the potentially desired content may be recorded or stored at faster or slower than normal speed originally appeared in claims 22, 53, 83 and 111. With regard to these claims, the Office action asserts that the "Wood teaches that video data is received and then compressed before [being] stored. The compression process inherently involves a delay due to processing, before storing, and therefore is stored at a slower than normal speed." It is respectfully submitted that delaying the storage of content because of the time necessary to compress the content is not the same as recording or storing at a faster or normal speed than normal. A delay in storage simply does not equate to change in the rate at which the content is recorded or stored. A delay is a shifting of time, whereas a rate change involves a change in an amount of data being recorded and/or stored and/or a change in the amount of time – not merely a shift. Accordingly, it is

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respectfully submitted that the Office action does not address the recording of potentially desired content at a rate faster or slower than normal, a recitation now present in all claims.

Gudesen is directed towards a system that provides on-demand services where programs are downloaded and stored locally. The programs are then replayed "without the use of an associated rapid and massive data transfer from an external source" and in "real time without the need for on-line transfer of the selected film" (Gudesen col. 1 lines 35-42). Thus Gudesen teaches a system that avoids transferring a "massive" amount of data "rapidly," i.e., faster than normal speed.

Since Wood does not have all the elements of the claims discussed herein, Wood does not anticipate the invention recited in claims 1-9, 17, 23-26, 29-35, 40, 48, 54-57, 60-65, 70, 78, 93, 78, 106, 112-115, and 118-120. "A claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Independent claims 1, 32, 63, and 93 have been amended to include the recitation that the potentially desired content can be recorded or stored at a rate faster or slower than normal. Neither Wood nor Gudesen discloses this recitation and, therefore, the combinations used as the bases for the obviousness rejections do not teach or suggest all of the claim limitations. No combination of the prior art suggests that the potentially desired content may be recorded or stored at rates faster or slower than normal. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must

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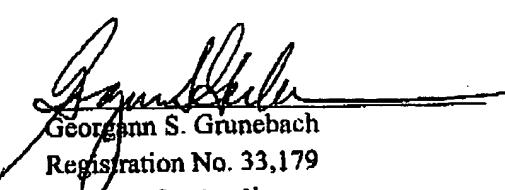
be taught or suggested by the prior art." M.P.E.P. 2143.03. "All of the words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Consequently, the obviousness rejection for claims 10-1, 12 14-16, 18-22, 27-28, 36-39, 41-43, 45-47, 49-53, 58-59, 66-69, 71-73, 75-77, 79-92, 94-97, 99-101, 103-105, 107-111, 116-117 cannot stand and the claims are in condition for allowance

Conclusion

Based on the foregoing amendments and remarks, it is respectfully submitted that claims 1-21, 23-52, 54-82, 84-110, and 112-120 are in condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

Respectfully submitted,

By:


Georgann S. Grunebach
Registration No. 33,179
Attorney for Applicants

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The DIRECTV Group, Inc.
RE / R11 / A109
P.O. Box 956
2250 E. Imperial Highway
El Segundo, CA 90245-0956

Phone: (310) 964-4615